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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/777,716

02/12/2004

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EXAMINER

VAUGHN, GREGORY J

ART UNIT

PAPER NUMBER

2178

DATE MAILED: 04/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/777,716	Applicant(s) KEOHANE ET AL.	
	Examiner Gregory J. Vaughn	Art Unit 2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2/12/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Action Background

1. This action is responsive to the application filing, application filed on 2/12/2004.
2. Claims 1-20 are pending in the case, claims 1, 7, 13 and 19 are independent claims.
3. Acknowledgement is made to the applicant's submission of an Information Disclosure Statement, filed 2/12/2004.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title."
5. Claims 1-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.
6. **Regarding claims 1-20**, the claimed invention fails to produce a useful, concrete or tangible result. The claimed invention as a whole must accomplish a practical application. That is, it must produce a *"useful, concrete and tangible result."* *State Street*, 149 F.3d at 1373, 47 USPQ2d at 1601-02. (See MPEP 2106.) Usefulness under the patent eligibility standard requires

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significant functionality to be present to satisfy the useful result aspect of the practical application requirement. See *Arrhythmia*, 958 F.2d at 1057, 22 USPQ2d at 1036. Merely claiming nonfunctional descriptive material stored in a computer-readable medium does not make the invention eligible for patenting. A process that consists solely of the manipulation of an abstract idea is not concrete or tangible. See *In re Warmerdam*, 33 F.3d 1354, 1360, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994). See also *Schrader*, 22 F.3d at 295, 30 USPQ2d at 1459.

Applicant's invention is directed toward protecting document content in a multi-user environment from deletion. Applicant's claims describe the steps taken to manipulate (determine and prevent) the nonfunctional descriptive material (the document content), but fail to provide a tangible result. The application describes a useful result on page 14, regarding, Figure 5, wherein a pop-up window notifies the user of the inventive function occurring, however the claims 1-20 fail to positively claim such a feature. Dependent claims 3, 9 and 15 are directed toward "*generating an indication*", however this feature fails to be useful unless the indication is given to the user, for instance, as the display shown in Figure 5.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

"A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States."

8. Claims 1-5, 7-11, 13-17 and 19-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Microsoft Excel 2000, copyright 1999 by Microsoft Corporation (hereinafter Excel). The examiner has provided screen snapshots of the Excel spreadsheet program in support of the rejection described herein.
9. **Regarding independent claim 1**, Excel discloses modifying a document in a data processing environment. Applicant's disclosure indicates that applicant's definition of a document includes documents generated by programs including word processors, spreadsheet programs, web design programs, and publishing programs (page 1, second and third paragraphs of the originally filed specification). Excel is well known as a spreadsheet program that provides for the generation and modification of spreadsheet documents.

Excel allows a user to select content within a document for deletion. Excel can determine whether the selected content is protected from deletion. Excel

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can prevent the deletion of the content. Figure 2 of Excel shows a spreadsheet. Figure 3 of Excel shows a user selection of spreadsheet cell C5. The user has selected the Delete key from the keyboard (not shown). Excel has responded to the delete request by the message shown in Figure 4 indicating that the cell is protected and cannot be modified. Excel has prevented the deletion of the content.

10. **Regarding dependent claim 2**, Excel discloses receiving a second user input that allows the deletion of the content. Excel's Figure 5 discloses a password entry box in which a user would enter a password that would allow the content to be deleted. In Figure 6, Excel discloses the content as being deleted (the data in cell C5 is gone).
11. **Regarding dependent claim 3**, Excel discloses an indication that the selected content is protected content in Figure 4.
12. **Regarding dependent claim 4**, Excel discloses an indication as highlighting the content as shown in Figure 3, wherein cell C5 is shown with highlighted (highlighting is indicated by a border around the cell).
13. **Regarding dependent claim 5**, Excel discloses the content as text. Although the example shows the protection of the numeric values in the document, the text values (row headings) are equally protected.
14. **Regarding claims 7-11**, the claims are directed to a system for the method of claims 1-5, and are rejected using the same rationale.

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15. **Regarding claims 13-17**, the claims are directed to computer readable media for the method of claims 1-5, and are rejected using the same rationale.
16. **Regarding claims 19 and 20**, the claims are directed to a system for the method of claims 1 and 2, and are rejected using the same rationale.

Claim Rejections - 35 USC § 103

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

"(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made."

18. Claims 6, 12 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Excel.
19. **Regarding dependent claim 6**, Excel discloses the use of a filter in Figure 7, however Excel fails to disclose the use of a grep Filter. However, applicant's disclosure describes a grep filter as: "A grep filter searches line by line for a specific pattern and outputs any line that matches the pattern" (page 13, second paragraph of the originally filed specification). Excel discloses in Figure 7, an advanced filter that filters the list in place, within a specified

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range in a sequential manner. So although Excel fails to explicitly describe a grep filter, Excel's filter is obviously performing the same function.

Therefore, it would have been obvious, to one of ordinary skill in the art, at the time the invention was made, to use the filtering functions of Excel as a grep filter in order to sequential review specific data.

20. **Regarding claims 12 and 18**, the claims are directed toward a system and a computer readable media, respectively, for the method of claim 6, and are rejected using the same rationale.

Conclusion

21. The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

<u>Patent/Publication</u>	<u>Date</u>	<u>Inventor</u>
• US-5,181,162 A	01-1993	Smith et al.
• US-6,640,249 B1	10-2003	Bowman-Amuah, Michel K.
• US-6,584,466 B1	06-2003	Serbinis et al.
• US-6,904,432 B2	06-2005	Charlot et al.
• US-2002/0019827 A1	02-2002	Shiman et al.
• US-2003/0137536 A1	07-2003	Hugh, Harlan M.
• US-2003/0120593 A1	06-2003	Bansal et al.
• US-2003/0200213 A1	10-2003	Charlot et al.
• US-2003/0227487 A1	12-2003	Hugh, Harlan M.


22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory J. Vaughn whose telephone

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number is (571) 272-4131. The examiner can normally be reached Monday to Friday from 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen S. Hong can be reached at (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is (571) 272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Gregory J. Vaughn
April 19, 2006